

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

MAURA A. FITZGERALD ET AL.

Group Art Unit: 3691

Examiner: Olaboder Akintola

Serial No.: 09/751,126

Filed: December 28, 2000

For: METHOD AND SYSTEM FOR AUTHORIZED NEGOTIABLE
INSTRUMENT ENCASHMENT

Attorney Docket No.: WEST 0106 PUS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner for Patents
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the final Office Action mailed October 28, 2008, Applicants request review of the legal and factual basis of the claim rejections discussed below. This Request is being filed with a Notice of Appeal.

REMARKS

Claims 1, 2, 5 and 7-27 are pending in the present application. Each of these claims were rejected. Applicants respectfully request review of the rejection of independent claims 1, 12, 13, 20 and 24 and their associated dependent claims.

Obviousness Rejection

Claims 1-2, 5, 7-9, 12-17 and 19-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,679,938, issued to Templeton *et al.* (hereinafter "*Templeton*"), in view of U.S. Patent No. 4,658,126, issued to May (hereinafter "*May*"). Claims 24-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Templeton* in view of *May*, in further view of U.S. Patent No. 6,226,624, issued to Watson *et al.* (hereinafter "*Watson*"), and/or U.S. Patent No. 6,311,170, issued to Embrey (hereinafter "*Embrey*"). Applicants respectfully traverse this rejection because *Templeton* and *May* are not properly combinable.

The Examiner attempts to combine *Templeton* and *May* (or modify *Templeton* based upon *May*) in order to reject independent claim 1. Claim 1 is directed to a method for processing a negotiable instrument including automatically printing a mark on a document "indicat[ing] that the negotiable instrument is *not* authorized for encashment." While *Templeton* relates to verifying an authorization status of a check, *Templeton* does not teach "upon an indication that the negotiable instrument is not authorized for encashment, automatically printing a mark on a document using a printer in communication with the terminal, wherein the mark corresponds with the sign and indicates that the negotiable instrument is not authorized for encashment." The Examiner concedes this point.

The Examiner contends that *May* cures the aforementioned deficiencies of *Templeton* because *May* "teaches returning a negotiable instrument to a payee with an indication of insufficient funds." (*Office Action*, p. 3.) However, *May* clearly teaches away from *Templeton*. *May* is directed to a check identification system whereby a payer's ID (*e.g.*, state

driver's license) is copied onto the back of the check upon acceptance by the payee. (*Abstract*.) The "indication of insufficient funds" described in *May* occurs after the check has already been cashed by the payee at some point in the future when the payee's bank attempts to collect from the payer's bank. (*May*, col. 2, ll. 56-68.) If the check bounces, it is then returned to the payee with the payer's ID on the back to aid in "the problem of collecting and legally enforcing collection of bad checks." (*May*, col. 1, ll. 15-28.)

It is axiomatic in the patent laws that "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." MPEP §2141.02 (citation omitted) (emphasis in original). Because the check in *May* is "passed into the payee's usual banking function" during encashment without obtaining any indication, one way or the other, regarding the authorization status of the check, one of ordinary skill in the art would not consider *May*, when viewed as a whole, to cure the deficiencies of *Templeton* relating to check encashment.

Accordingly, reconsideration and withdrawal of the rejection of independent claim 1 and associated dependent claims under 35 U.S.C. §103(a) for at least the reasons set forth above is respectfully requested. Since the rejections of independent claims 12, 13, 20 and 24 each rely on the improper combination of *Templeton* and *May*, withdrawal of their corresponding rejections under 35 U.S.C. §103(a) for at least the reasons set forth above with respect to claim 1 is likewise solicited.

The remarks set forth above are presented in an effort to limit the issues for a Pre-Appeal conference. This is done without acquiescing or conceding the Examiner's position with respect to any other rejections, and without conceding any other arguments (previously presented or not) that render the Examiner's rejections erroneous. A Pre-Appeal Brief conference is respectfully requested to consider the remarks and to pass the case to issue.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayments as a result of the filing of this paper to Deposit Account No. 02-3978.

Respectfully submitted,

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